

Notice of Allowability

Application No.

09/954,494

Examiner

Vickie Kim

Applicant(s)

CASTILLO, JAMES G.

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to examiner's amendment requested on August 10, 2004.
2. ☒ The allowed claim(s) is/are 2-4,6,12,15 and 17.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Vickie Kim
Primary Examiner
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EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mrs. Defillo, Evelyn on August 12, 2004.

2. The application has been amended as follows:

- a. Cancel claims 8-11, 13-14 and 16.
- b. In claim 2, line 1, replace [16] with --- 17 --- right after "claim".
- c. In claim 3, line 1, replace [16] with --- 17 --- right after "claim".
- d. In claim 4, line 1, replace [16] with --- 17 --- right after "claim".
- e. In claim 6, line 1, replace [16] with --- 17 --- right after "claim".
- f. In claim 12, line 1, replace [10] with --- 17 --- right after "claim" and
- g. In claim 12, line 2, replace [penetration enhancing agent] with --- solvent -- right after "volatile".
- h.. In claim 15, line 1, replace [14] with --- 17 --- right after "claim".
- i. In claim 17, lines 1-2, insert --- enhancing an anesthetic effect by -- .
- j. In claim 17, lines 15-16, delete [wherein the volatile solvent is present in the formulation in amounts between 67-80%.].
- k. In claim 17, line 18, replace [:] with -- ; -- right after "solvent".

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I. In claim 17, line 23, insert -- ; wherein the anesthetic is chosen from benzocaine, butambenpicrate, tetracaine, dibucaine, prilocaine, etidocaine, mepivacaine, bupivacaine, lidocaine, proprionic acid derivatives, fenamates, pyrrolealkanoic acids, pyrazolone derivatives, oxicams, pramoxine, an eutetic mixture of lidocaine and prilocaine, or mixture thereof -- right after "lipophilic base".

Conclusion

3. All the pending claims 2-4, 6, 12, 15 and 17 are allowed.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 571-272-0579. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Low Christopher can be reached on 571-272-0953. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Vickie Kim', with a long horizontal flourish extending to the right.

VICKIE KIM
PRIMARY EXAMINER
Primary Examiner
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